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EXAMINER

OCAMPO, MARIANNE S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 04/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/836,546

Applicant(s)

SERVO ET AL.

Examiner

Marianne S. Ocampo

Art Unit

1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 16 January 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 5, 10-13 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-9, 14-16 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 5, 10-13 and 17 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 16 January 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. This application contains claims 5, 10 – 13 and 17 drawn to an invention non-elected with traverse in Paper No. 5. A complete reply to a final rejection must include cancelation of non-elected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 8 – 9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a filter element (or filter unit) comprising a filter cloth which can be formed into a tubular filter bag, does not reasonably provide enablement for a filter unit which comprises a filter cloth and an additional or secondary filter element in the form of a (substantially triangular) tubular filter bag made from filter cloth, as in claims 8 - 9. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. In the

original specification, there is support only for the filter cloth as the filtering element which is pre-formed as a bag corresponding to the shape of the sector element which is triangular in shape, as in page 6, lines 2 – 4 and in lines 21 – 25. There is no support either from the original specification or drawings for a filter unit having two filter elements (i.e. one being the filter cloth arranged against the filter surfaces of the sector element and another being a tubular filter bag made of a filter cloth also being arranged around the sector element, as in claims 8 - 9).

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 - 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Kramer (US 3,918,726).

6. Concerning claim 1, in this rejection, the examiner has considered only the fastening strip to be the claimed invention, which is a subcombination, and not the combination thereof with a solid-liquid separator having the features recited in the preamble of claim 1 and therefore,

does not require all the particulars of the solid-liquid separator. Kramer discloses a fastening strip (13) capable of fastening a filter cloth to a filter element of a solid-liquid separator, being an elongated piece having a substantially T-formed cross section and comprising a fastening portion (13b) made of flexible material and dimensioned such that it is capable of being deformed (only for installation purposes, as in the abstract) upon insertion into a fastening groove of a filter element for fastening the filter cloth thereto and generating a fastening force and a support portion (13a) that is transverse to the fastening portion and capable of remaining outside the fastening groove (as in fig. 2) and extending a predetermined distance from an edge of the fastening groove on both sides thereof, as in figs. 1 – 2 and cols. 2 – 3.

7. With regards to claim 2, similarly as in claim 1 above, the examiner has considered only the fastening strip to be the claimed invention, which is a subcombination, and not the combination thereof with a solid-liquid separator having the features recited in the preamble of claim 1 and therefore, does not require all the particulars of the solid-liquid separator nor that of a filter element. Kramer further discloses at least a surface of the support portion (which could face a filter element or the surface being the one engaging a portion of the groove onto which a filter element would be fastened thereto) being curved, as in figs. 1 – 2.

8. Claims 1 - 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Vaugin (FR 2,350,521).

9. Concerning claim 1, in this rejection, the examiner has considered only the fastening strip to be the claimed invention, which is a subcombination, and not the combination thereof with a solid-liquid separator having the features recited in the preamble of claim 1 and therefore, does not require all the particulars of the solid-liquid separator and/or the filter element. Vaugin discloses a fastening strip (10) capable of fastening a filter cloth to a filter element of a solid-liquid separator, being an elongated piece having a substantially T-formed cross section and comprising a fastening portion (16) made of flexible material and dimensioned such that it is capable of being deformed (only for installation purposes, as in the abstract) upon insertion into a fastening groove (which may have a smaller opening than the outer dimensions of the fastening portion of the strip) of a filter element for fastening the filter cloth thereto and generating a fastening force and a support portion (11, 12) that is transverse to the fastening portion (16) and capable of remaining outside the fastening groove (as in fig. 2) and extending a predetermined distance from an edge of the fastening groove on both sides thereof, as in figs. 2 & 5 and pages 3 – 4 and see translated abstract (Derwent abstract attached hereto).

10. With regards to claim 2, similarly as in claim 1 above, the examiner has considered only the fastening strip to be the claimed invention, which is a subcombination, and not the combination thereof with a solid-liquid separator having the features recited in the preamble of claim 1 and therefore, does not require all the particulars of the solid-liquid separator nor that of a filter element. Vaugin further discloses at least a surface (12) of the support portion (which

could face a filter element or the surface being the one engaging a portion of the groove onto which a filter element would be fastened thereto) being curved, as in figs. 2 & 5.

11. With respect to claim 3, Vaugin also discloses the support portion (12) narrowing towards transverse edges of the fastening strip, as in figs. 2 & 5.

12. With regards to claim 4, Vaugin further discloses the support portion comprising a flat portion (11) on a surface which would be opposite a filter element (upon assembly/sealing with a fastening groove which contacts the filter element), as in figs. 2 & 5.

13. Regarding claim 6, Vaugin also discloses the fastening portion (10, 16) being made of flexible compressible material, in the form of an elastomeric material, as in the translated abstract attached hereto.

14. Claims 1 – 2, 4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Koito Mfg. Co. Ltd. (JP 53-036577).

15. Concerning claim 1, in this rejection, the examiner has considered only the fastening strip to be the claimed invention, which is a subcombination, and not the combination thereof with a solid-liquid separator having the features recited in the preamble of claim 1 and therefore, does not require all the particulars of the solid-liquid separator and/or the filter element. Koito

discloses a fastening strip (g) capable of fastening a filter cloth to a filter element of a solid-liquid separator, being an elongated piece having a substantially T-formed cross section and comprising a fastening portion (L) made of flexible material and dimensioned such that it is capable of being deformed (only for installation purposes, as in the abstract) upon insertion into a fastening groove (which may have a smaller opening than the outer dimensions of the fastening portion of the strip) of a filter element for fastening the filter cloth thereto and generating a fastening force and a support portion (g) that is transverse to the fastening portion (L) and capable of remaining outside the fastening groove (as in figs. 3 – 4 & 6) and extending a predetermined distance from an edge of the fastening groove on both sides thereof, as in figs. 3 - 4 & 6 and see translated abstract (Derwent abstract attached hereto).

16. With regards to claim 2, similarly as in claim 1 above, the examiner has considered only the fastening strip to be the claimed invention, which is a subcombination, and not the combination thereof with a solid-liquid separator having the features recited in the preamble of claim 1 and therefore, does not require all the particulars of the solid-liquid separator nor that of a filter element. Koito further discloses at least a surface of the support portion (which could face a filter element or the surface being the one engaging a portion of the groove onto which a filter element would be fastened thereto) being curved, as in figs. 3 - 4 & 6.



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17. With regards to claim 4, Koito further discloses the support portion comprising a flat portion (g) on a surface which would be opposite a filter element (upon assembly/sealing with a fastening groove which contacts the filter element), as in figs. 3 - 4 & 6.

18. Regarding claim 6, Koito also discloses the fastening portion (10, 16) being made of flexible compressible material, in the form of a rubber material, as in the translated abstract attached hereto.

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 1, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denhard (US 2,061,351) in view of Lipscomb et al. (US 4,879,318).

21. Concerning claim 1, in this rejection, the examiner has considered only the fastening strip to be the claimed invention, which is a subcombination, and not the combination thereof

with a solid-liquid separator having the features recited in the preamble of claim 1. Denhard discloses a fastening strip (gasket 12) capable of fastening a filter cloth to a filter element of a solid-liquid separator, being an elongated piece having a substantially T-formed cross section and comprising a fastening portion capable of being deformed upon insertion into a fastening groove of a filter element for fastening the filter cloth thereto and generating a fastening force and a support portion that is transverse to the fastening portion and capable of remaining outside the fastening groove and extending a predetermined distance from an edge of the fastening groove on both sides thereof. Denhard discloses the fastening strip (12) being formed of a gasket material which is generally known in the art to be formed of a rubber (which is generally flexible) material (see definition of "gasket" given by Webster Dictionary, p. 481, 10<sup>th</sup> edition). Lipscomb et al. teach a T-shaped fastening strip/gasket (17) similar to that of Denhard being made of a flexible material, as in fig. 3 and in col. 4, lines 52 – 53. It is considered obvious to one of ordinary skill in the art at the time of the invention to modify the material of construction of the fastening strip of Denhard to particularly that of rubber or any flexible material, as taught by Lipscomb et al., in order to provide a fastening strip with inherent deformable and sealing abilities.

22. With regards to claim 6, it is well known in the art that rubber (which could be for example, NBR or nitrile rubber) as the material of construction for the gaskets/fastening strips (12) of Denhard, is among those considered as flexible compressible (i.e. elastic) material. (See

Hawley's Condensed Chemical Dictionary, page 792 for properties of nitrile rubber, and Webster Dictionary, page 1022 for definition of "rubber").

23. Regarding claim 4, similarly as in claim 1 above, the examiner has considered only the fastening strip to be the claimed invention, which is a subcombination, and not the combination thereof with a solid-liquid separator having the features recited in the preamble of claim 1 and therefore, does not require all the particulars of the solid-liquid separator nor that of a filter element. Denhard also discloses the support portion comprising a flat portion on a surface *opposite the filter element (2, 4)*, which is the surface opposite the surface from which the fastening portion extends from, as in fig. 3.

24. Claims 7, 14 – 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crane et al. (US 3,283,906) in view of Vaugin (FR 2350521).

25. Regarding claim 7, Crane et al. disclose a filter unit for a disc filter (A) wherein the disc filter (A) comprises a body portion that is rotatable around its horizontal axis and on whose periphery are arranged two or more filter units (12) that form a disciform structure, and the filter unit comprising a sector element (40 - 51), a filter cloth (116) and a fastening strip/bolt (120), the sector element (such as 40) comprising a neck portion (adjacent plenum 90, 86, 82) for fastening the sector element (40) to the body portion (10, A) of the disc filter (A), a flat substantially triangular hollow blade portion (110, 112) comprising an outer edge (in the vicinity of the

fastening bolt 120) at the edge opposite to the neck portion (82), lateral faces transverse to the direction of rotation and flank surfaces (defined by plates 110, 112) in the direction of rotation and the flank surfaces being provided with holes (114) and act as filter surfaces, the filter cloth (116) being arranged against said filter surfaces and the sector element (40) comprising at least one fastening groove wherein a fastening strip (or bolt, 120) is being arranged for fastening the filter cloth (116) on the sector element (40) and the fastening strip (120) being an elongated piece having a substantially T-shaped cross section and comprising a fastening portion (the portion of the bolt/strip which sits in the groove) which generates a fastening force and a support portion that is transverse to the fastening portion and remaining outside the fastening groove and extending a predetermined distance from an edge of the fastening groove on both sides thereof, as in figs. 1 – 7 and in cols. 1 – 5. Crane et al. fail to disclose the fastening portion of the strip being made of a flexible material and dimensioned so that it is deformed when inserted into the fastening groove. Vaugin teaches a fastening strip (10) being an elongated piece having a substantially T-shaped cross section and comprising a fastening portion (the portion of the strip which would sit in a fastening groove of a filter unit/sector, 16) which is made of a flexible (elastomeric) material and dimensioned so that it could be deformed when inserted into the fastening groove and generate a fastening force and a support portion (11, 12) that is transverse to the fastening portion (16) and would remain outside the fastening groove and extend a predetermined distance from an edge of the fastening groove on both sides thereof, as in figs. 2 & 5 and pages 3 – 4 and English translated abstract (see Derwent abstract of FR 2350521 attached). It is considered obvious to one of ordinary skill in the art at the time of the invention

to modify the fastening bolt of Crane et al., by substituting it with a fastening strip taught by Vaugin in order to provide an alternative fastening element which is made of a material of construction considered to be more durable and has elastic properties that would not require having special contours made onto its surface (such as threads) to fit into a groove to which it will be fastened/received thereby, and would not corrode or rust easily compared to its metallic (bolts) counterparts.

26. With regards to claim 14, Crane et al. as modified by Vaugin, also teach at least a surface (upon assembly onto the filter/sector element would be facing the filter cloth/element) of the support portion (11, 12) of the fastening strip (10) being curved, as in figs. 2 and 5. It is considered obvious to one of ordinary skill in the art at the time of the invention to modify the (shape of) at least one surface of the support portion such that it is curved in order to provide a means for compressing the support portion onto the filter element (or any part to which it is sealed thereby) for a more effective sealing or joining therewith, as in the English translated abstract.

27. Concerning claim 15, Crane et al. as modified by Vaugin, further teach the support portion (particularly at 12) of the fastening strip (10) narrowing towards transverse edges of the strip (10), as in figs. 2 and 5. The case law, *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966), provided (The court held) that the configuration of the claimed invention (in this instance, having a narrowing support portion towards transverse edges of the strip) was a matter of choice

which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed invention was significant.

28. With respect to claim 16, Crane et al. as modified by Vaugin, further teach the support portion (11, 12) of the fastening strip (10) comprising a flat portion (11) on the surface which would be opposite to the sector element (as a result of the combination), as in figs. 2 and 5.

29. With regards to claim 18, Crane et al. as modified by Vaugin, the fastening strip (10) being made of a flexible compressible material, such as an elastomeric material, as in the abstract.

30. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crane et al. and Vaugin, as applied to claim 7 above, and further in view of Simonson (US 4,139,472).

31. Regarding claim 8, Crane et al. further disclose the fastening groove being arranged at an outer edge of the blade portion, and the filter cloth (filter element) having a wider end and a narrower end, wherein the narrower end is being fastened by fastening elements (120) around the neck portion of the sector element and the edges of the wider end being fastened to fastening grooves of the sector element by means of fastening bolts/strips (120), as in figs. 4 - 5 & 7. *In this particular claim rejection, the examiner has considered that the tubular filter bag*

*and the filter cloth already mentioned in claim 7 being one and the same element, and this claim is not adding an additional/secondary filter element in the form of a tubular filter bag.* Crane et al. as modified by Vaugin, fail to teach the filter cloth (filter element) being in the form of a tubular filter bag which is open at both its ends and comprising a wider end and a narrower end, and the tubular filter bag being arranged around the sector element and the narrower end thereof being fastened by means of fastening elements around the neck portion of the sector element and the edges of the wider end being fastened to the fastening groove of the sector element by means of the fastening strip. Simonson teach a filter unit comprising a sector element (50, 60), a filter cloth in the form of a tubular filter bag (28) and a fastening strip (124) and the sector element (50, 60) comprising a neck portion (78) for fastening the sector element to a body portion of a disc filter similar to that of Crane et al., a flat substantially triangular hollow blade portion (50, 52, 48) comprising an outer edge at the edge opposite the neck portion, lateral faces transverse to a direction of rotation and flank surfaces in the direction of rotation, and the flank surfaces having holes (62) and act as filter surfaces and the filter bag/cloth (28) being arranged against the filter surfaces and the filter bag/cloth (28) being open at both its ends, and comprising a wider end and a narrower end arranged around the sector element (50, 60) wherein the narrower end thereof being fastened by means of fastening elements (such as a string or rope tie 116) around the neck portion (78) of the sector element and the edges of the wider end being fastened to the fastening groove of the sector element by means of the fastening strip (124), as in figs. 1, 4 & 7 and in cols. 3 –5. It is considered obvious to one of ordinary skill in the art at the time of the invention to modify the filtering element of the filter unit of Crane et al. as modified by Vaugin,

by substituting the filter cloth/screen element with a filter bag medium as taught by Simonson, as an alternative design and provide a filter element which provides a greater filtering surface area (by having the filtering cloth/element surrounding the entire sector element and not just its flank surfaces) than the one taught by Crane et al.

32. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crane et al. and Vaugin, as applied to claim 7 above, and further in view of Peterson et al. (US 3,485,376).

33. Concerning claim 9, Crane et al. as modified by Vaugin, also teach a fastening groove (into which the fastening rods 37 ) are disposed and arranged at least on one lateral face of the blade portion of the sector element (40), as in fig. 4. *In this particular claim rejection, the examiner has considered that the tubular filter bag and the filter cloth already mentioned in claim 7 being one and the same element, and this claim is not adding an additional/secondary filter element in the form of a tubular filter bag.* Crane et al. as modified by Vaugin, fail to teach the filter cloth being in the form of a substantially triangular filter bag having a closed wider end and an open narrower end arranged around the sector element, the side of the filter bag comprising an opening from which the filter bag is arranged onto the sector element and edges of the opening being fastened by means of the fastening strip to the fastening groove (arranged) at the (least on one) lateral face of the blade portion and the narrower end being fastening by fastening elements around the neck portion of the sector element. Peterson et al. teach a filter unit similar to that of Crane et al., comprising a sector element (22), a filter cloth (24) in the form



of a substantially triangular filter bag, the filter bag (24) having a closed wider end (at 24a, 24c, 24e) as in figs. 10 – 11, and an open narrower end (24i, 24h) arranged around the sector element, the side (24b) of the filter bag comprising an opening from which the filter bag is arranged onto the sector element and edges of the opening being fastened by means of the fastening strip (94, 96) to the fastening groove (arranged) at the (least on one) lateral face of the blade portion and the narrower end being fastening by fastening elements (29) around the neck portion of the sector element, as in figs. 5 – 6 & 17 – 23 and in cols. 4 – 8. It is considered obvious to one of ordinary skill in art at the time of the invention to modify the filtering element of the filter unit of Crane et al. as modified by Vaugin, by substituting the filter cloth/screen element with a filter bag medium as taught by Peterson et al., as an alternative design and provide a filter element which provides a greater filtering surface area (by having the filtering cloth/element surrounding the entire sector element and not just its flank surfaces) than the one taught by Crane et al..

### ***Response to Arguments***

34. Applicant's arguments with respect to claims 1 – 4, 6 – 9, 14 – 16 and 18 have been considered but are moot in view of the new grounds of rejection based on the newly found prior art presented above. **This action is non-final.**

*Conclusion*

35. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP 53-036577 (Koito Mfg. Co. Ltd), 5,318,422 (Erland), 2,885,083 (Peterson et al.), 2,964,194 (Oliver Jr. et al.) and 3,760,544 (Hawes et al.).

36. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne S. Ocampo whose telephone number is (703) 305-1039. The examiner can normally be reached on Mondays to Fridays from 8:00 A.M. to 4:30 P.M..

37. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

38. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
M.S.O.

March 31, 2003

  
JOSEPH DRODGE  
PRIMARY EXAMINER